



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2023-0008]

Patent Center Electronic Office Action Program

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice; request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) will begin transitioning to the Patent Center Electronic Office (e-Office) Action program upon publication of this notice. The Patent Center e-Office Action program is designed to modernize the e-Office action process and further streamline the USPTO's service delivery processes. Implementation of the Patent Center e-Office Action program is another step in the USPTO's transition to Patent Center, a more modern, user-friendly system that provides improved system performance and a more intuitive user experience. Once fully implemented, the Patent Center e-Office Action program will replace the existing e-Office Action program available to users of the Private Patent Application Information Retrieval (PAIR) system. In addition, the Patent Center e-Office Action program offers a new option for users to receive courtesy postcards by email (e-postcards) as a reminder that there are available USPTO communications that have not been viewed or downloaded. The USPTO is implementing the e-postcard option based on feedback from customers, particularly to reduce paper consumption and mitigate the impact of potential postal delays. Through this notice, the USPTO seeks public comments on eliminating the postal postcard for all Patent Center e-Office Action program users in the future. As with the existing program, participation in the Patent Center e-Office Action program is optional.

DATES: Comments must be received by [INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE *FEDERAL REGISTER*] to ensure consideration.

ADDRESSES: For reasons of government efficiency, comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, enter docket number PTO-P-2023-0008 on the homepage and click “Search.” The site will provide a search results page listing all documents associated with this docket. Find a reference to this document and click on the “Comment” icon, complete the required fields, and enter or attach your comments. Attachments to electronic comments will be accepted in Adobe® portable document format (PDF) or Microsoft Word® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT: Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-7727; or Kristie A. Mahone, Senior Legal Advisor, Office of Patent Legal Administration, at 571-272-9016; or patent.practice@uspto.gov. For technical questions, please contact the Patent Electronic Business Center (EBC) at 1-866-217-9197 (toll-free), 571-272-4100 (local), or ebc@uspto.gov. The Patent EBC is open from 6 a.m. to midnight ET, Monday-Friday.

SUPPLEMENTARY INFORMATION:

In May 2009, the USPTO implemented the e-Office Action program as an option for all users of the Private PAIR system. See Electronic Office Action, 1343 Off. Gaz. Pat. Office 45 (June 2, 2009). Under the Private PAIR e-Office Action program, the USPTO emails applicants notifications of Office communications retrievable through Private PAIR, rather than mailing the communications through the United States Postal Service (USPS), with a few exceptions. Participants in the Private PAIR e-Office Action program are also sent a courtesy postcard through the USPS as a reminder when none of the new Office communications listed in the email notification have been viewed or downloaded within seven calendar days after the date of the email notification and at least one of the listed Office communications requires the applicant's reply.

On August 1, 2022, the USPTO replaced the public view of the PAIR system (Public PAIR) with Patent Center, which offers a single interface for electronic filing and the management of patent applications. Patent Center, once fully developed, will replace EFS-Web and the Private PAIR system. Upon publication of this notice, the USPTO will begin migrating participants in the Private PAIR e-Office Action program to the Patent Center e-Office Action program by Customer Number to modernize the e-Office Action process and continue streamlining its service and delivery processes. Current Private PAIR participants will not be required to make any changes to their Customer Number to participate in the Patent Center program.

Under the Patent Center e-Office Action program, Patent Center will send an improved, easier-to-read email notification listing retrievable Office communications to participating users. Those users may view and download the listed Office communications in Patent Center. Users will also be sent a courtesy postcard through the USPS when none of the Office communications listed in the email notification have been viewed or downloaded in Patent Center within seven calendar days after the date of the

notification and at least one of the listed Office communications requires the applicant's reply.

In addition to Patent Center's enhanced user interface experience, Patent Center e-Office Action program participants may choose to receive e-postcards. Once a participant elects to receive e-postcards, the USPTO will no longer mail courtesy postcards through the USPS if none of the Office communications have been viewed or downloaded in Patent Center within seven calendar days after the date of the email notification and at least one of the Office communications requires an applicant's reply. Instead, the USPTO will send a courtesy e--postcard, as discussed in item 5 below.

The USPTO will endeavor to migrate all participants from the Private PAIR e-Office Action program to the Patent Center e-Office Action program expeditiously. The transition is expected to be complete approximately four weeks from the publication of this notice. Participation in the Patent Center e-Office Action program will be optional. Participants may withdraw by following the procedure set forth in item 7 of this notice.

The following enumerated paragraphs revise the guidance for the Private PAIR program to incorporate the technical modifications arising from the implementation of the Patent Center e-Office Action program, as well as the new e-postcard option. The USPTO seeks comments on eliminating the postal postcard default option and will evaluate whether maintaining a postal postcard is necessary based on feedback from the public. The USPTO will provide advance notice of the changes to the Patent Center e-Office Action program detailed in this notice.

1. *Who may participate in the Patent Center e-Office Action program, and how should new users register?*

Any registered attorney or agent of record, or a named inventor acting pro se, in a patent application that is associated with a Customer Number is eligible to participate in the Patent Center e-Office Action program by accessing Patent Center. To access Patent Center, the participant must have a registered MyUSPTO account linked to the participant's Customer Number. For information on the creation of a MyUSPTO account and the method for accessing Patent Center, please contact the Patent EBC.

To register for the Patent Center e-Office Action program and receive email notifications of subsequent Office communications, Patent Center users must:

- a. log in to Patent Center and select "Manage/Manage customer numbers";
- b. select the Customer Number to enroll;
- c. select "Edit";
- d. select the "Receive correspondence notification via Email" option within the "Edit customer" screen; and
- e. designate at least one email address to receive email notifications for Office communications issued in the applications associated with the Customer Number.

The user may designate up to three email addresses. After registration, Office communications entered by participating USPTO business units (see item 7 below) in each application associated with the Customer Number will be processed under the Patent Center e-Office Action program.

2. How does the Patent Center e-Office Action program work?

When one of the participating business units within the USPTO enters an Office communication in an application that is associated with a registered Customer Number, the USPTO will send an email notification to the designated email addresses. The email notification will contain the following information: (a) the date and time the USPTO sends the email notification, (b) the Customer Number, and (c) information regarding each new Office communication. The Office communication information will include: (i) the application number of the application in which the Office communication is entered;

(ii) the document code associated with the Office communication; (iii) the mailroom/notification date indicated on the form PTOL-90, which accompanies the Office communication (generally, any time period for reply set forth in the Office communication will commence on the mailroom/notification date (see item 4 below)); and (iv) the attorney docket number.

The Office communication will be available and retrievable immediately through Patent Center. The USPTO will not mail a paper copy of the Office communication. Upon receipt of the email notification, the participant can download or view the new Office communication by logging in to Patent Center and using either: (a) the “Workbench/View correspondence” option, or (b) the “Application Search” option, and accessing the “Documents & Transactions” tab.

If the user has multiple applications associated with the Customer Number, a single consolidated email notification will be sent to the user, and it will list all the new Office communications entered on that day in the applications associated with the Customer Number. An abridged version of the email notification that contains only data pertinent to an individual application will be scanned into that application file as part of the official record. The abridged email notification scanned into the application file will not contain information regarding other applications.

3. *How often will a participant receive the email notification?*

The USPTO will send an email notification to the designated email addresses only when there is a new Office communication in the applications associated with the participant’s Customer Number. If there are multiple new Office communications entered in the applications on the same day, the participant will receive a single email notification listing all the new Office communications. Therefore, participants will receive a single

email notification per day for each Customer Number when there is a new Office communication.

4. *When does the time period for reply start?*

Generally, any time period for reply set forth in the Office communication will commence on the mailroom/notification date indicated on the form PTOL-90 accompanying the Office communication. The mailroom/notification date is treated like the mailing date of a paper communication. More specifically, for Office actions under 35 U.S.C. 132(a), the mailroom/notification date is the date of the notice under 35 U.S.C. 133. See *Electronic Office Action*, 1343 Off. Gaz. Pat. Office at 46. The mailroom/notification date will also be considered the date of mailing of the correspondence for all other purposes (e.g., 37 CFR 1.71(g)(2), 1.97(b), 1.701-1.705).

However, the 63-day time period set forth in 37 CFR 90.3 for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit, or for commencing a civil action, begins on the date of the decision of the Patent Trial and Appeal Board (PTAB). The time period is not measured from the mailroom/notification date. See also 35 U.S.C. 142. Participants may request extensions of time pursuant to 37 CFR 90.3(c).

Once the participant receives an email notification, the USPTO highly recommends that the participant log in to Patent Center to view the new Office communication as soon as possible to determine whether the communication requires a reply and when the reply is due.

5. *What is a courtesy postcard?*

The USPTO will send a courtesy postcard notifying the applicant if none of the Office communications listed in the email notification are viewed or downloaded through Patent Center within seven calendar days after the date of the email notification and at least one of the Office communications requires an applicant's reply. The courtesy

postcard will be mailed through the USPS to the correspondence address associated with the Customer Number, unless the participant opts to receive courtesy e-postcards.

Patent Center e-Office Action participants may opt to receive courtesy e-postcards rather than courtesy postcards mailed through the USPS. To elect between receiving postal postcards and e-postcards for subsequent email notifications, a Patent Center participant must:

- a. log in to Patent Center and select “Manage/Manage customer numbers”;
- b. select the Customer Number to change the postcard notification method;
- c. select “Edit”;
- d. select “Receive postcard notification via Email” for the e-postcard option;
or
- e. select “Receive postcard notification via Postal mail” for the postal mail option within the “Edit customer” screen.

If a participant has elected to receive e-postcards, the USPTO will no longer mail a courtesy postcard through the USPS if none of the Office communications have been viewed or downloaded in Patent Center within seven calendar days after the date of the email notification and at least one of the Office communications requires an applicant’s reply. Courtesy e-postcards will be emailed to the same email addresses assigned to the Customer Number for the correspondence address.

The mailing or sending of a courtesy postcard will not restart any time period for reply. The time period for reply will continue to run from the mailroom/notification date indicated on the form PTOL-90 accompanying the Office communication.

6. *What types of applications are included in the Patent Center e-Office Action program?*

The program includes provisional applications filed under 35 U.S.C. 111(b); nonprovisional applications filed under 35 U.S.C. 111(a) (including utility, plant, design, and reissue applications); and international applications that have entered the national

stage under 35 U.S.C. 371. International applications that have not entered the national stage in the United States, reexamination proceedings, and PTAB trial proceedings are not included in the program.

7. *Which business units at the USPTO participate in the Patent Center e-Office Action program?*

Participants will receive email notifications for all Office communications prepared by the following participating business units:

- a. Technology Centers (including the examining corps), which enter Office actions and notices, including notices of allowance;
- b. The Office of Patent Application Processing, which enters application formality review notices, including notices to file missing parts;
- c. The Office of Data Management (Pre-Grant Publications and Office of Publications), which enters notices of publication and issues patents;
- d. The PTAB for ex parte appeals of rejections of claims in patent applications;
- e. The Office of Petitions; and
- f. The Office of Licensing and Review.

Since several areas of the Office have independent mailing processes, participants will continue to receive paper mailings for communications prepared by the non-participating business units, including (but not limited to):

- a. The Patent Cooperation Treaty Operations Division, International Branch;
- b. The PTAB for trial proceedings and reexamination proceedings;
- c. The Central Reexamination Unit for ex parte reexamination and inter partes reexamination proceedings;
- d. The Office of Enrollment and Discipline; and
- e. The Office of the Solicitor.

8. *Can a participant withdraw from the Patent Center e-Office Action program?*

Participants may opt out of the program at any time. To change back to paper delivery of any subsequent Office communications, Patent Center users must:

- a. Log in to Patent Center and select the “Manage/Manage customer numbers” screen;
- b. Select the Customer Number to opt out;
- c. Select the “Edit” button; and
- c. Select the “Receive correspondence via Postal mail” option on the “Edit customer” screen.

Any Office communications prepared after the withdrawal is recognized by the USPTO will be mailed to the correspondence address associated with the application. However, if the Office communication has been prepared before the withdrawal is recognized by the USPTO, the Office communication may be processed under the email notification procedure. This means that the USPTO may send an email notification for the communication rather than mailing a paper copy of the communication. Prior to the completion of the withdrawal process, participants may receive some Office communications on paper (those that were prepared after the withdrawal was recognized) and email notifications for those that were prepared before the withdrawal was recognized. Therefore, it is important for the participants to check their designated email addresses for email notifications and review the Office communications via Patent Center, even after withdrawing from the program. Furthermore, the participants may receive courtesy postcards in the previously elected mode (postal postcard or e-postcard) for any unviewed communication (that has a time period for reply) for which an email notification was sent.

9. *Can a participant change or add email addresses?*

Participants may change email addresses at any time. To change or add an email address, a participant must:

- a. Log in to Patent Center and select “Manage/Manage Customer Number”;
- b. Select the “Edit” button; and
- c. Change or add the email address to receive email notifications for Office

communications entered in the applications associated with the Customer Number. The participant may designate up to three email addresses. The Patent Center system will send a test email to each of the new email addresses associated with the Customer Number.

10. Who should a participant contact if an email notification for an Office communication has not been received?

The participant should contact the Patent EBC if an Office communication is available in Patent Center but the participant did not receive an email notification for the Office communication. The USPTO will take appropriate corrective actions. For example, the USPTO will send the participant an email notification if an email notification was not previously sent to the designated email addresses. Any time period for reply (except for the 63-day time period under 37 CFR 90.3) set forth in the Office communication will be restarted when the USPTO sends the email notification. For more information on the time period for reply, see item 4 above.

However, if the USPTO did send an email notification to each of the email addresses designated by the user, the USPTO will not send a new email notification, and any time period for reply set forth in the Office communication will not be restarted. The time period for reply will continue to run from the original mailroom/notification date. Therefore, it is important for the user to designate the correct email addresses when signing up for the program.

11. Who should a participant contact if an improper communication has been scanned into the application?

The participant should contact the Patent EBC if an improper communication has been scanned into the application file, so that the USPTO can take appropriate corrective actions. For example, if the improper communication belongs to another application, the USPTO will move the communication to the correct application. The USPTO will send a new email notification when a proper communication is available and retrievable through Patent Center.

Please note that the document code corresponding to an Office communication identified on the email notification is informal (unofficial) information. If there is any discrepancy between the document code corresponding to an Office communication identified on the email notification and the document code corresponding to the image of the communication available through Patent Center, the document code corresponding to the image of the Office communication available through Patent Center is the official record. The USPTO will not send a new email notification for an incorrect document code on the email notification.

If an Office communication contains an error that affects an applicant's ability to reply to the Office communication and this error is called to the attention of the USPTO in writing within one month of the email date, the USPTO will follow the procedure set forth in section 710.06 of the Manual of Patent Examining Procedure (MPEP) (9th ed., rev. 7.2022, February 2023).

12. Who should the participant contact if the date of the email notification is a few days later than the mailroom/notification date?

If the Office communication (e.g., an application filing receipt or a notice of publication) does not require a reply from an applicant and it does not have a time period

for reply, it is not necessary for the participant to contact the Office. However, if the Office communication requires a reply and it sets forth a time period for reply, the participant should call the Patent EBC within one month from the email date so the USPTO can reset the time period for reply (except for the 63-day period under 37 CFR 90.3) to the original email date. For more information on the time period for reply, see item 4 above.

For example, an email notification sent on October 6, 2022, could indicate that an Office action with a mailroom/notification date of October 3, 2022, has been entered in the application. The time period for reply set forth in the Office action commences on the mailroom/notification date (October 3, 2022). If the participant contacts the Patent EBC within one month from the email date (October 6, 2022), the USPTO will reset the time period for reply to commence on October 6, 2022.

13. How can a participant identify the email notification sent from the Office?

The email notification will have the following language in the subject line: “USPTO: Patent Electronic System - Correspondence Notification for Customer Number xxx,” where “xxx” will be the participant’s Customer Number. The sender’s address will be “noreply@uspto.gov.” Any inquiries regarding the email notification should be directed to the Patent EBC. Participants should not reply to the “noreply” email address.

14. Does the Patent Center e-Office Action program change the policy for communications via the internet?

By registering for the Patent Center e-Office Action program, a participant is authorizing the USPTO to send email notifications of Office communications entered by the participating USPTO business units in the applications associated with the Customer Number. The Patent Center e-Office Action program does not, otherwise, change the policy for communications via the internet as set forth in section 502.03 of the MPEP.

The Patent Center e-Office Action program does not alter the USPTO's policy prohibiting an applicant or examiner from engaging in improper email correspondence. For example, the applicant may not send a reply to an Office action to the USPTO via email, and the examiner may not send an Office action to the applicant via email. See section 502.03 of the MPEP.

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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